

Appl. No.: 09/800,083  
Amdt. Dated: January 03, 2005  
Off. Act. Dated: August 2, 2004

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. **Rejection of Claims 1-13 and 16 under 35 U.S.C. §103(a).**

Claims 1-13 and 16 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Birrel et al. (U.S. Patent No. 6,009,462) in view of Ambler et al. (U.S. Patent No. 6,393,456).

Applicant has carefully considered this rejection and responds as follows. In response to the rejection, the Applicant respectfully submits that the rejection suffers from a number of intractable shortcomings.

#### **NO TEACHING IN CITED REFERENCES TO SUPPORT REJECTION**

The most clearly evident problem with the rejection is that there exist no teachings within either Birrell et al. or Ambler et al. which comport to the elements of Applicants claims. A description of this problem and examples will be discussed below. A number of additional problems exist with the rejection including, elements in references are not equivalent, new principle of operation utilized, solved a different problem, lack of specificity of suggestion to modify, references do not add up to the invention, unworkable combination, useless combination, impossible to combine, proposed combination renders reference unsuited for intended purpose, no need of element within references, unsuggested combination, no motivation to combine, and that invention is to be considered as a whole and not examined as a collection of pieces.

**Claims 1 and 11.** Claims 1 and 11 are the independent claims within the Application.

Claim 1. This claim recites elements within "*a system for sending temporally displaced electronic messages over a network*". The Examiner concedes that "*Birrell et*

*al does not explicitly disclose that the sending system configured to encode a temporal specifier into an electronic message; and the retention system configured to decode the temporal specifier of the electronic message to the destination in accord with the specified temporal specifier".* However, the contention that Ambler et al. provides teachings which comport with these aspects of Applicant's claims is unfounded.

#### CITED REFERENCE DOES NOT PROVIDE RELIED-UPON TEACHINGS

Ambler et al. teaches a workflow processing system and does not disclose encoding a temporal specifier. None of the sections of Ambler, however large, within the reference disclose a temporal specifier which controls the length of retention by another system on the network prior to delivery to the destination.

In support of using Ambler et al. the Examiner references "(figure 1; column 13 line 29 to column 14 line 54; and column 15 line 48 to column 16 line 17)".

"*Figure 1*" - Ambler describes this figure: "*FIG. 1 is an example system that provides a suitable operating environment for the present invention.*" The figure contains only a general purpose computer connected to a network through peripherals. It is clear that this figure does not even disclose the aspects that Ambler is teachings, let alone specific temporal specifier aspects of Ambler. Also see Col. 10, Line 10 - 46, which provides additional clarity on the general nature of the figure. There is nothing which comports to Applicant's Claim 1.

"*Column 13 line 29 to column 14 line 54*" - In this section of the Ambler reference (not very specific as it spans the majority of a page), there is nothing whatsoever which speaks of a temporal specifier. Ambler does discuss transmitting and receiving "*workflow specifications*" (see Col. 13, Line 55), which is the purpose to which the invention was created, as evidenced by the title and throughout the specification. There is certainly no mention of encoding a temporal specifier in the email to control retention of the message before deliver to the recipient. More specifically there is nothing described to "encode a temporal specifier into an electronic message to be sent over said network to a recipient at a destination address on the

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network” and further nothing described which can “decode the temporal specifier of said electronic message, store said electronic message, and send said electronic message to the destination in accord with the specified temporal specifier”. There is nothing which comports to Applicant’s Claim 1.

“Column 15 line 48 to column 16 line 17” - This section comprises a portion of the claims of Ambler et al. which describe encoding a workflow specification into an email. It is instructive to realize that these are MIME and/or XML encoded entities or can comprise a workflow language for the specification. Nothing within this comports to the temporal specifier teachings recited in Applicant’s Claim 1. There is nothing which comports to Applicant’s Claim 1.

Therefore, as Ambler et al. does not teach what it is purported to teach and does not therein support the rejection, the rejection of Claim 1 and the claims which depend therefrom should be withdrawn.

Claim 11. This independent claim recited a method of “*sending electronic messages over a network which are to be delivered to a recipient at a destination address at a predetermined later time*”. The claim recites additional distinctions which are not addressed in the rejection. Claim 11 is allowable for the reasons outlined above, while it also provides further distinctions, such as the “*extracting of the time coordinate from the electronic message*”, “*retaining the message until the specified time coordinate arrives*”, and so forth.

Claim 2-10, 12-13, and 16. These claims depend from Claims 1 and 11 whose patentability over the cited references has been demonstrated, wherein these claims should be considered a *fortiori* allowable.

In addition a number of these claims recite elements which can not be equated to aspects of either the Birrell et al. or Ambler et al. references, including but not limited to the following.

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Claims 4-5, 12-13. - These dependent claims describe the retention system being an ISP. There is no discussion within either reference of an ISP retaining messages, let alone it retaining message until the temporal specifier arrives.

Claim 8. - This dependent claims describes the retention system adding content. There is no discussion of ISP retaining message until a temporal specifier arrives, and there is nothing in these references in which an ISP adds content.

Claims 9, 10. No discussion of encoding commands for altering how the delivery is to take place in response to the temporal specifier, or of escalating the form of delivery.

Claim 16. This dependent claim describes how the sender can edit and amend emails which are retained awaiting the arrival of the temporal specifier. As the relied upon references do not support the retention of the messages by an ISP awaiting the temporal specifier they certainly do not support this added feature.

Rejection of a claim for obviousness based on a single reference requires a *prima facie* showing of some teaching, suggestion, motivation or incentive to modify the reference to yield the claimed invention.

In summary, neither the Birrell or Ambler reference provide teachings which comport with the invention as claimed. Applicant has not even delved into the other problems with the rejection as the above is clearly sufficient to illustrate that a *prima facie* case of obviousness has not been established.

## 2. Addition of Claims 17-20.

Claim 17. This independent claim was added bringing the total of independent claims to three (3). This claim recites elements of Claim 1 with Claim 11 in another form and includes dependent element already recited. Specifically this claim is directed at the system from an ISP software perspective.

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Claim 18. This dependent claim contains the elements of original claims 14-15.

Claim 19. This dependent claim expands on the "extracting" of the temporal specifier from the electronic message, which is described in the specification including page 27, line 15, as well as throughout the specification.

Claim 20. This dependent claim recites more clearly how the temporal specifier is encoded in the message according to an embodiment, such as described through page 8 of Applicant's specification, and throughout.

It should be appreciated that the original claims remain and these claims are in line with the teaching of these claims, wherein the addition of the claims does not necessitate additional searching or efforts on the part of the Examiner.

3. Additional Claim fees.

No additional claim fees, still within the 3/20 covered by the basic filing fee.

4. Extension of Time Petition.

The Applicant has enclosed a petition for a two-month extension of time to respond to the Office Action and has enclosed the appropriate petition fee. *(Note that end of the second month response period ended on a weekend wherein the response was mailed the monday after the weekend and is still within that period of time.)*

5. Conclusion.

The response describes why the relied-upon references do not establish a prima facie case of obviousness contrary to patentability of those claims. Applicant respectfully contends that all claims are patentable over these references and that the rejection of all claims should be withdrawn. Each of these presently pending claims in this application are believed to be in immediate condition for allowance.

The Applicant respectfully requests a response/interview (email/phone) with the Examiner to clarify any issues that arise upon examination on the merits of the present

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application, if an allowance of all claims does not appear forthcoming.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rodger H. Rast", written in a cursive style.

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